

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Dwight Allen Merriman et al. Art Unit : 3714
Patent No. : 7,930,207 Examiner : Ronald Laneau
Issue Date : April 19, 2011 Conf. No. : 5600
Serial No. : 10/798,340
Filed : March 12, 2004
Title : METHOD OF DELIVERY OF TARGETING, AND MEASURING
ADVERTISING OVER NETWORKS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 49 days to 367 days is respectfully requested.

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentees respectfully submit that the Office did not apply the proper standard for determining the period of “B Delay” under 35 U.S.C. § 154(b)(1)(B).

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

Applicant Delay

A reply to an Office Action was due on or before October 28, 2004 (the date that is three months after July 28, 2004, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on December 28, 2004, thereby according an Applicant Delay of 61 days. Patentees do not dispute the PTO’s calculation for this Applicant Delay from October 29, 2004 (the day after the date that is three months after the date on which the Office Action was mailed), to December 28, 2004. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before July 7, 2005 (the date that is three months after April 7, 2005, the date on which the Office Action was mailed). Patentees filed a

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: June 20, 2011.

response to the Office Action on October 7, 2005, thereby according an Applicant Delay of 92 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from July 8, 2005 (the day after the date that is three months after the date on which the Office Action was mailed), to October 7, 2005. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before February 16, 2006 (the date that is three months after November 16, 2005, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on May 16, 2006, thereby according an Applicant Delay of 89 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from February 17, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to May 16, 2006. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before November 3, 2006 (the date that is three months after August 3, 2006, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on December 4, 2006, thereby according an Applicant Delay of 31 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from November 4, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to December 4, 2006. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before September 12, 2007 (the date that is three months after June 12, 2007, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on November 13, 2007, thereby according an Applicant Delay of 62 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from September 13, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to November 13, 2007. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before April 17, 2008 (the date that is three months after January 17, 2008, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on May 19, 2008, thereby according an Applicant Delay of 32 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from April 18, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to May 19, 2008. See 37 C.F.R. § 1.704(b).

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A reply to an Office Action was due on or before December 3, 2008 (the date that is three months after September 3, 2008, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on March 3, 2009, thereby according an Applicant Delay of 90 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from December 4, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to March 3, 2009. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before November 6, 2009 (the date that is three months after August 6, 2009, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on December 7, 2009, thereby according an Applicant Delay of 31 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from November 7, 2009 (the day after the date that is three months after the date on which the Office Action was mailed), to December 7, 2009. See 37 C.F.R. § 1.704(b).

Patentees filed an Information Disclosure Statement on May 27, 2010, subsequent to a reply filed on May 21, 2010. Patentees were accorded 0 days delay for a supplemental response. In good faith and candor, Patentees submit that the supplemental response should have been accorded a total Applicant Delay of 6 days for delay from May 22, 2010, to May 27, 2010. See 37 C.F.R. § 1.704(c)(8).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 494 days (i.e., the sum of 61 days, 92 days, 89 days, 31 days, 62 days, 32 days, 90 days, 31 days, and 6 days).

"A Delay"

A PTO action was due on or before June 5, 2007 (the date that is four months after February 5, 2007, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on June 12, 2007, thereby according a PTO Delay of 7 days. Patentees do not dispute the PTO's calculation for this "A Delay" from June 6, 2007 (the day after the date that is four months after the date on which a response to Office Action was filed), to June 12, 2007. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 7 days.

“B Delay”

There is no dispute that the Office failed to issue a patent within three years of the filing date of the application and that Patentees are entitled to “B Delay” to compensate for that Office delay. The only issue in contention is the correct length of the “B Delay” period.

The period beginning on March 13, 2007 (the day after the date that is three years after the date on which the application was filed), and ending April 19, 2011 (the date the patent was issued), is 1,499 days in length. The “PTA 36 Months” entry in the PAIR/PALM system indicates that a total of 530 days were awarded for “B Delay” for this patent. Patentees respectfully submit that the PTO’s calculation of this “B Delay” is incorrect.

When Does “B Delay” Occur

As outlined in Wyeth v. Kappos, 93 U.S.P.Q. 2d 1257 (Fed. Cir. Jan. 7, 2010, affirming Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008)), the period of B Delay begins on the day after the date that is three years from the filing of the application and concludes upon the issuance of the patent:

Correspondingly, a violation of the B guarantee—the one at the heart of the issue in this case—begins when the PTO fails “to issue a patent within 3 years after the actual filing date of the application in the United States” *Id.* § 154(b)(1)(B). It ends when “the patent is issued.” *Id.* The “period of delay” under the express language of the B clause therefore runs from the three-year mark after filing until the application issues.

Id.

Excluded from the “B Delay” calculation by 35 U.S.C. § 154(b)(1)(B) is “any time consumed by continued examination of the application requested by the applicant.” *Id.* In the present matter, the PTO has excluded time that does not correspond to time consumed by continued examination of the application.

Excluded from the “B Delay” calculation by 35 U.S.C. § 154(b)(1)(B) is “time consumed by appellate review by the Board of Patent Appeals and Interferences.” *Id.* In the present

matter, the Board of Patent Appeals and Interferences (“the Board”) never reviewed an appeal proffered by Patentees.

How Does Filing a Notice of Appeal Affect “B Delay?”

Properly excluded from a calculation of “B Delay” is “time consumed by appellate review by the Board of Patent Appeals and Interferences.” See 35 U.S.C. § 154(b)(1)(B). As applied by the Office in the calculation of PTA for the instant patent, 37 C.F.R. § 1.703(b)(4) appears to exclude from “B Delay” time periods *not* encompassed by actual appellate review and is therefore inconsistent with the controlling statute. In particular, the Office’s regulation excludes from “B Delay” time starting from when a Notice of Appeal is filed. This reduction of “B Delay” is a clear deviation from the requirements of 35 U.S.C. § 154(b)(1)(B), as it begins an exclusion before any potential appellate review ever takes place. “Appellate review,” if it ever occurs at all after a Notice of Appeal is filed, cannot occur until jurisdiction passes to the Board of Patent Appeals and Interferences.

By its unambiguous meaning, “appellate review by the Board of Patent Appeals and Interferences” can only occur when the Board reviews an appeal. In this case, a Notice of Appeal was filed on December 4, 2006. An appeal brief was filed on February 5, 2007, and the next substantive action issued by the Office was a non-final Office Action on June 12, 2007.

In the Notice of Appeal period, the Examiner withdrew the finality of the rejection without filing an Examiner’s answer. The case never proceeded to the jurisdiction of the Board, the Board never reviewed the case (nor could it before an Examiner’s answer), and no decision was ever issued by the Board – either in favor of the Applicant or in favor of the Office. Clearly, no appellate review by the Board of Patent Appeals and Interferences occurred after the filing of the Notice of Appeal. As such, no reduction of “B Delay” is provided for by 35 U.S.C. § 154(b)(1)(B) in this instance.

How Is “B Delay” Calculated in the Instant Patent?

The “PTA 36 Months” entry in the PAIR/PALM system indicates that the Office awarded 530 days for application pendency of more than three years (i.e., “B Delay”).

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the period between the filing of a Notice of Appeal and the issuance of a Notice of Allowance must be excluded from the “B Delay” calculation. Yet, in the instant patent, no time was actually “consumed by appellate review by the Board of Patent Appeals and Interferences” as provided for in 35 U.S.C. § 154(b)(1)(B).

Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of B Delay “any time consumed by continued examination of the application.” In the present matter, Requests for Continued Examination were filed on July 2, 2009, May 21, 2010, and September 14, 2010. The Director erred in the calculation of patent term adjustment by subtracting from B Delay a period of time that was not “consumed by continued examination of the application.” The PTO mailed a Notice of Allowance on December 1, 2010, thereby closing examination of the application on that date. Thus, no continued examination took place during the 140 day period from December 1, 2010 (the mailing date of the Notice of Allowance), until April 19, 2011 (the date the patent was issued). Accordingly, 140 days of “B Delay” should have been included in addition to the 530 days accorded by the Director.

In the instant case, “B Delay” should be calculated as 861 days, the period of time from March 13, 2007 (the day after the date that is three years after the date on which the application was filed), to July 2, 2009 (the date on which a Request for Continued Examination was first filed), and December 1, 2010 (the mailing date of the Notice of Allowance), until April 19, 2011 (the date the patent was issued).

Overlap of “A Delay” and “B Delay”

As detailed above, 7 days of “A Delay” accumulated during the following period:

June 6, 2007, to June 12, 2007.

As detailed above, 861 days of “B Delay” accumulated during the following periods:

March 13, 2007, to July 2, 2009; and

December 1, 2010, to April 19, 2011.

As such, the periods of “A Delay” and “B Delay” overlap (i.e., occur on the same calendar day) for a total of 7 days, from June 6, 2007, to June 12, 2007.

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Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 49 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 861 days (i.e., the sum of 7 days of "A Delay" and 861 days of "B Delay" minus 7 days overlapping delay);
- 2) Total Applicant Delay should be calculated as 494 days; and
- 3) Total PTA should be calculated as 367 days.

The \$200 fee required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other credits or charges to Deposit Account No. 06-1050, referencing Attorney Docket No. 16113-1341007.

Respectfully submitted,

Date: June 20, 2011

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